

## REMARKS

Presently claims 1-5, 7-8, and 10-12 are pending in this application. Claim 1 has been amended. Applicant respectfully thanks the Examiner for accepting the previously submitted Drawings Applicant will now respectfully address the Examiner's objections and rejections.

### Rejections under 35 U.S.C. 102(b)

Claims 1-4, 8, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,624,376 to Ball ("Ball" hereinafter). Applicant respectfully traverses.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Applicant's amended claim 1 recites *inter alia*,

"whereby incus and stapes are *permanently* disconnected so that the incus can move independently from the stapes."

The Examiner states at page 3 of the Office Action that "the incus and stapes are naturally configured to be loosely attached in a swiveling fashion such that they may move independently from one another within the range of that swivel limitation, and thus can be considered "disconnected so as to move independently" by their natural physiological construction. Thus, this clause in the instant application does not add further limitation beyond the natural physiology of the inner ear." Applicant respectfully disagrees with the Examiner's assertion that the incus and stapes are naturally disconnected.

As the Examiner is certainly aware, the incus and stapes transfer sound via amplification of mechanical movements of the tympanic membrane CC, and transfer of the

amplified movements to the inner ear. The incus and stapes do this together with the third ossicle (i.e. the malleus). The three ossicles form a chain, such that they are arranged one behind the other. If one ossicle does not properly move, the sound transfer to the inner ear is impaired. This is clearly expressed in Ball '376 as follows: "Some patients with hearing loss have ossicles that lack the resiliency necessary to increase the force of vibrations to a level that will adequately stimulate the receptor cells in the cochlea" (col. 1, lines 55-58). Ball continues after this sentence as follows, "Other patients have ossicles that are broken, and which therefore do not conduct sound vibrations to the oval window." Thus, as this passage of Ball clearly indicates, the incus and the stapes of a healthy human ear are not *disconnected* (i.e. severed) from each other. Therefore, the incus and stapes are not disconnected via their natural physiology as the Examiner asserts, and will only be disconnected in a healthy ear via the surgical disarticulation referred to by the Examiner, or any other disarticulation (such as the one mentioned by Ball).

The Examiner also refers to Fig. 7, stating that Ball teaches a surgically separation of the incus from the stapes. However, this separation is only taught in Ball to occur when a transducer is implanted around the stapes HH. The passage of Ball cited by the Examiner, namely, in col. 10, 47-51, Ball describes the incus and stapes to be reconnected, wherein the incus and stapes "are then returned to their natural position and where the connective tissue between then heals *and causes them to reconnect*." Thus, this passage teaches that the two ossicles are only temporarily disconnected, but are in connection (reconnected) to allow hearing. Applicant respectfully points out however, that claim 1 has been amended to recite permanent disconnection.

Similarly, with regards to the Examiner's discussion of Figure 9, Ball teaches a complete ossicle chain, wherein the stapes has been replaced by a "partial ossicular prosthesis" (col.11, lines 1-4). As is clearly shown in Figure 9, the prosthesis takes the place of the stapes, rendering the ossicle chain uninterrupted (i.e. not disconnected). Furthermore, the Examiner's argument that this removal of the stapes (i.e. replacement with the prosthesis) would render the stapes disconnected from the incus is respectfully overcome by Applicant's positive recitation of a stapes in the claims. Thus, without a

stapes present, the embodiment of Figure 9 does not teach “a stapes” at all, as is recited in the claims.

For at least the above reasons, Ball fails to disclose all of the limitations of amended Claim 1. Accordingly, Ball does not anticipate amended Claim 1. Applicant respectfully submits that Claim 1 is not further rejected or objected and is therefore allowable. Claims 2-4, 8, and 10-11 depend from Claim 1, are not further rejected or objected to, and thus, are also correspondingly allowable. Reconsideration and allowance of Claims 1-4, 8, and 10-11 are respectfully requested.

#### Rejections under 35 U.S.C. 103(a)

Claim 5 is rejected under 35 U.S.C. 103(a) as being obvious over Ball in view of United States Publication No. 2002/0138115 to Baumann (“Baumann” hereinafter). Applicant respectfully traverses.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art and that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

As claim 5 depends from claim 1, for at least the reasons discussed in the 102 remarks above, Ball does not teach every element of claim 5. Since Baumann does not remedy the above discussed deficiencies of Ball, the proposed combination of Ball and Baumann fails to teach or suggest all of the limitations of claim 5. As the proposed combination of Ball and Baumann does not teach every element of claim 5, clearly, one of ordinary skill at the time of Applicant’s invention would not have a motivation to modify or combine Ball and Baumann, or a reasonable likelihood of success in forming the

claimed invention by modifying or combining Ball and Baumann. For at least these reasons, Applicant respectfully submits that *prima facie* obviousness does not exist with regards to claim 5.

Claims 7 and 12 are also rejected under 35 U.S.C. 103(a) as being obvious over Ball in view of United States Patent No. 5,531,787 to Lesinski et al. (“Lesinski” hereinafter), in further view of United States Patent No. 6,398,717 to Leysieffer et al. (“Leysieffer” hereinafter). Applicant respectfully traverses.

As claims 7 and 12 depends from claim 1, for at least the reasons discussed in the 102 remarks above, Ball does not teach every element of claims 7 and 12. Since neither Lesinski nor Leysieffer remedy the above discussed deficiencies of Ball, the proposed combination of Ball, Lesinski, and Leysieffer fails to teach or suggest all of the limitations of claims 7 and 12. As the proposed combination of Ball, Lesinski, and Leysieffer does not teach every element of claims 7 and 12, clearly, one of ordinary skill at the time of Applicant’s invention would not have a motivation to modify or combine Ball, Lesinski, and Leysieffer, or a reasonable likelihood of success in forming the claimed invention by modifying or combining Ball, Lesinski, and Leysieffer. For at least these reasons, Applicant respectfully submits that *prima facie* obviousness does not exist with regards to claims 7 and 12.

Conclusion

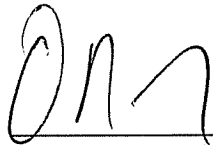
The rejections herein overcome. Entry of the present Response with Amendment and prompt issuance of a Notice of Allowance are respectfully requested.

Applicant hereby petitions for any necessary extension of time required for consideration of this Response.

Please charge any fees due with respect to this Response, or otherwise regarding the application, to Deposit Account 06-1130 maintained by Applicant's attorneys.

The Office is invited to contact Applicants' attorneys at the below-listed telephone number regarding this Response or otherwise concerning the present application.

Respectfully submitted,

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Date: September 17, 2007